

REMARKS

Claims 37-58 are pending in the present application.

Applicants wish to thank Examiner Rodee for the indication that Claims 40-43 are allowable and that Claims 52-58 are allowed (page 4 of the Office Action mailed January 3, 2005). Reconsideration of the outstanding rejections is requested in view of the amendments and remarks set forth herein.

The rejection Claims 37-39 under 35 U.S.C. §103(a) over Tachikawa et al (U.S. 5,069,992) is obviated by amendment.

Tachikawa et al (U.S. 5,069,992) is cited as disclosing an electrophotographic printing plate precursor having an electroconductive support and a photoconductive layer thereon (page 3 of the Office Action mailed January 3, 2005). The Examiner asserts that the photoconductive layer disclosed by Tachikawa et al contains an alkali-soluble polyurethane resin that is obtained by reacting a diisocyanate of formula (I) and a carboxyl group-containing diol of formula (II), (III), or (IV), only formula (II) of which is remotely close to the claimed polyurethane resin.

The Examiner recognizes that the polyurethane resin disclosed by Tachikawa et al differs from that of the claimed invention in that R2 defined in Tachikawa et al is a C<sub>1-8</sub> alkyl group while the corresponding position in the invention claimed in Claim 37 has 9 to 28 carbon atoms (page 3 of the Office Action mailed January 3, 2005). Applicants further note that position R5 in formula (II) of Tachikawa et al is connected with a carboxyl group. In contrast, the corresponding position (R3) in the invention claimed in Claim 37 is a substituted

or unsubstituted alkyl group. Noting the list of alternative substituents for R3 appearing in the specification at page 25, line 20 to page 26, line 11 and page 27, lines 10-12, which does not include a carboxyl group, Applicants have amended Claim 37 to clearly distinguish the scope of claimed polyurethane resins appearing in Claim 37, and the claims dependent therefrom, from those disclosed in Tachikawa et al.

In view of the fact that formula (II) of Tachikawa et al requires the presence of a carboxyl group substituting the position corresponding to R3 in the invention claimed in Claim 37, Applicants submit that there would be no motivation to alter the disclosure of Tachikawa et al. As such, Applicants submit that the present invention is not obvious in view of the disclosure of Tachikawa et al.

Applicants request acknowledgment that this ground of rejection has been withdrawn.

Finally, with respect to the non-elected method claims, Applicants remind the Examiner that MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Accordingly, upon a finding of allowability of the elected product claims, Applicants respectfully request rejoinder of the withdrawn process claims that depend therefrom or include all the limitations of the elected claims.

Application Serial No. 10/735,929  
Response to Office Action mailed January 3, 2005

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Vincent K. Shier, Ph.D.  
Registration No. 50,552

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 08/03)